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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/582,451	07/19/2006	James John Schmitt	ACM3027P1US	6765
27624	7590	11/18/2011	EXAMINER	
AKZO NOBEL INC. LEGAL & IP 120 WHITE PLAINS ROAD, SUITE 300 TARRYTOWN, NY 10591			MCGUTHRY BANKS, TIMA MICHELE	
			ART UNIT	PAPER NUMBER
			1733	
			NOTIFICATION DATE	DELIVERY MODE
			11/18/2011	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES JOHN SCHMITT
and RONALD GEERT SMEINK

Appeal 2010-001580
Application 10/582,451
Technology Center 1700

Before TERRY J. OWENS, PETER F. KRATZ, and
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-9. We have jurisdiction under 35 U.S.C. § 6.

STATEMENT OF THE CASE

Claims 1 and 5 are representative of the subject matter on appeal and are set forth below:

1. A process for producing iron ore agglomerates comprising agglomerating fine iron ore particles in the presence of a binder system that comprises a binder and an alkali metal silicate, wherein the alkali metal

silicate is present in an amount of between 0.0001 to 0.07 percent by weight, based on the total weight of dry iron ore agglomerate, and wherein the binder system is free of synthetic polymer.

5. A binder system for producing iron ore agglomerates comprising carboxymethyl cellulose and an alkali metal silicate.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Johnson	3,554,792	Jan. 12, 1971
Allen ¹	4,728,537	Mar. 1, 1988
Field	6,293,994 B1	Sep. 25, 2001
Cobett	6,743,275 B1	Jun. 1, 2004

THE REJECTIONS

1. Claims 1 and 4 are rejected under 35 U.S.C. § 103(a) as obvious over Cobett.
2. Claims 1, 3, 4, and 9 are rejected under 35 U.S.C. § 103(a) as obvious over Field.
3. Claims 2 and 5-8 are rejected under 35 U.S.C. § 103(a) as obvious over Field in view of Allen.

¹ The Examiner incorrectly identified Allen as U.S. Patent No. 4,278,537 on page 3 of the Answer. The correct patent number is U. S. Patent No. 4,728,537.

4. Claims 5 and 8 are rejected under 35 U.S.C. § 102(b) as anticipated by Johnson.

ANALYSIS
(with Findings of Fact and Principles of Law)

As an initial matter, Appellants have not presented separate arguments for all of the rejected claims. Rather, Appellants' arguments are principally directed to independent claims 1 and 5. Any claim not separately argued will stand or fall with its respective independent claim. *See* 37 C.F.R. § 41.37(c)(1) (vii).

Rejection 1

Issue:

Did the Examiner err in determining that Cobett suggests the claimed invention, in particular, the amount of sodium silicate as recited in claim 1, and that Appellants rebuttal evidence is unconvincing?

We answer this question in the negative and AFFIRM.

Appellants assert that Cobett does not teach sodium silicate in a range of at most 10%, but rather, in a range of at most 20%. Br. 11. We disagree and refer to column 2, line 1 of Cobett wherein Cobett specifically teaches that “preferably at least 90% by weight of ferrous metal with the balance being an alkali metal silicate and other inorganic impurities, such as silicate sand.”

Appellants then acknowledge that a prior art reference (Cobett) that discloses a range encompassing a somewhat narrow range establishes a *prima facie* case. Br. 11. Appellants refer to Table 1 on page 9 of their

Specification as evidence of improved performance in an effort to rebut the prima facie case. Br. 11-12. We are unconvinced by this data for the following reasons.

Appellants have the burden of rebutting a prima facie case of obviousness. For example, the burden is on Appellants to show why the comparative data establishes unexpected results. *See In re Klosak*, 455 F.2d 1077, 1080 (CCPA 1972). Appellants must also explain why the showing is commensurate in scope with the claimed subject matter. *See In re Boesch*, 617 F.2d 272, 276 (CCPA 1980).

In the instant case, Appellants have failed to show why the comparative data establishes unexpected results. Appellants refer to the data in Table 1 as evidence of “improved performance” (Br. 11) rather than as unexpected results.

Also, Appellants have not provided data that is commensurate in scope with the claims. For example, the claims are not limited to the type of binder (Peridur 330) used in the examples of Table 1. *See* Specification 8:9-17.

Additionally, the comparisons set forth in Table 1 (p. 9 of the Specification), having the corresponding properties as set forth in Table 2 (p. 11 of the Specification) are directed to Examples 1-4 (having 0.03, 0.05, 0.06, and 0.08wt% sodium silicate, respectively) compared with comparative examples 1 and 2 (having 0.0 and 0.20wt% sodium silicate, respectively). Values between 0.08 and 0.20 are not provided; not to say that every such value is required, but additional values would have assisted in establishing criticality regarding the claimed amount of sodium silicate.

As such, it is difficult to ascertain what amount of sodium silicate establishes criticality from the data in Table 1, and Appellants do not provide a convincing explanation as to how the data in Tables 1 and 2 establishes criticality for the claimed range of “between 0.0001 to 0.07 percent by weight, based on the total weight of the dry iron ore agglomeration”.

In view of the above, we, therefore, agree with the Examiner’s position, and affirm Rejection 1.

Rejections 2 and 3

Issue:

Did the Examiner err in determining that Field suggests the claimed invention, in particular, the claimed amount of alkali metal silicate as recited in claim 1?

We answer this question in the affirmative and REVERSE.

It is the Examiner’s position that Field’s teaching of “above 0.08% based on the moist mix” suggests Appellants’ claimed invention of an amount of alkali metal silicate between “0.0001 to 0.07 percent by weight, based on the total weight of dry iron ore agglomerate” as recited in claim 1. Ans. 4.

We first note that “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The Examiner has not met this burden in the instant case. The Examiner refers to MPEP § 2144.05 I to support his assertion that Field’s disclosed amount is “close enough” to Appellants’ claimed range such that one skilled in the art would have expected the same properties. This is a reference to the case of

Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 783 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of “having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium” as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). However, the Examiner does not adequately explain how the law of *Titanium Metals Corp. of Am. v. Banner* is applicable to the facts in the instant case in view of the different fact scenario before us (i.e., in the instant case, Field teaches amounts “above 0.08%” which is a different fact scenario than the facts in *Titanium Metals Corp. of Am.*). See Answer generally. Furthermore, Appellants point out that Field teaches amounts above 0.08%, and argues that therefore Field would not have led one skilled in the art to amounts less than this amount. Br. 13-15; Reply Br. 6-8. Notably, the Examiner does not provide an adequate explanation as to why one skilled in the art would have been motivated to use amounts less than the amount taught by Field. See Answer generally. Finally, the Examiner has not explained how Field’s disclosed amount based upon the moist mix correlates with Appellants’ claimed amount based upon the total weight of the dry iron ore agglomeration. *Id.*

The about- mentioned circumstances lead us to agree with Appellants’ position, and we, therefore, reverse Rejections 2 and 3 (the secondary reference of Rejection 3 does not cure the deficiencies of Field).

Rejection 4

Issue:

Did the Examiner err in determining that Johnson anticipates the binder system recited in claim 5?

We answer this question in the negative and AFFIRM.

Appellants argue that claim 5's preamble of "a binder system for producing iron ore agglomerates" distinguishes from the composition of Johnson because the composition of Johnson is not capable of producing iron ore agglomerates. Br. 19-20; Reply Br. 9-10. Assuming, for argument sake, that the preamble provides this claim interpretation that Appellants seek, Appellants have not adequately demonstrated that the composition of Johnson is not capable of producing iron ore agglomerates. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602 (CCPA 1965); *In re Geisler*, 116 F.3d 1465 (Fed. Cir. 1997).

In view of the above, we, therefore, affirm Rejection 4.

CONCLUSIONS OF LAW AND DECISION

1. Rejection 1 is affirmed
2. Rejections 2 and 3 are reversed.
3. Rejection 4 is affirmed.

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TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED-IN-PART

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